

REMARKS

Claims 1-20 and Claims 22-23 are pending in the present application.

Claim 21 has been previously canceled.

Claim 1 has been objected to.

Claims 1-20 and Claims 22-23 have been rejected.

Claims 24-25 have been added.

Claim 1 and Claim 23 have been amended.

Reconsideration of the claims is respectfully requested.

Claim 24 and Claim 25

It is clear that the Amendment of March 2, 2004 contained Claim 24 and Claim 25. (Amendment of March 2, 2004, Page 10, Lines 1-4). The Amendment of March 2, 2004 was submitted to be entered with the Request for Continued Examination of May 25, 2004. However, Claim 24 and Claim 25 were inadvertently deleted when the Applicants submitted a listing of claims on August 16, 2004 in response to a Notice of Non-Compliant Amendment dated August 11, 2004. Because Claim 24 and Claim 25 were present in the Amendment of March 2, 2004, the Applicants have re-submitted Claim 24 and 25 in this Amendment.

Specification – Title of the Invention

The Examiner stated that the previous objection to the title has been overcome. The title of the invention is now WIRELESS DAY PLANNER PORTFOLIO SYSTEM.

Specification – Corrections to Text

The Applicants have amended certain portions of the text of the specification to correct typographical errors. No new matter has been added as a result of these amendments.

The expression “means for connecting 410” on Page 12, Line 6 of the specification has been corrected to read “means for communicating 410.” The correct expression “means for communicating 410” appears on Page 11, Line 3 of the specification. Therefore no new matter has been added as a result of this amendment.

Corrections to Published Patent Application

The Applicants note the existence of the following typographical errors in the published patent application US 2001/0040561 A1 published on November 15, 2001:

(1) The two words “day planner” from the specification have been written together as one word “dayplanner” in Line 2 of Paragraph [0006].

(2) The word “based” from the specification has been incorrectly repeated in Line 13 of Paragraph [0008]. Correction of these typographical errors is respectfully requested.

Claim Objections

The Examiner objected to Claim 1 because Claim 1 recited “the communication device” instead of “the first communication device.” The Applicants have amended Claim 1 to make the appropriate correction.

35 U.S.C. § 103 (Obviousness)

On Pages 3-6 of the October 1, 2004 Office Action, the Examiner rejected Claims 1-10, Claim 13 and Claim 23 under 35 U.S.C. § 103 (a) as being unpatentable over United States Patent No. 6,282,433 to Holshouser (hereafter *Holshouser*) in view of United States Patent No. 5,835,721 to Donahue et al. (hereafter *Donahue*).

On Pages 6-8 of the October 1, 2004 Office Action, the Examiner rejected Claims 11-12 and Claim 22 under 35 U.S.C. § 103 (a) as being unpatentable over *Holshouser* in view of *Donahue* and further in view of United States Patent No. 5,786,921 to Wang et al. (hereafter *Wang*).

On Pages 8-10 of the October 1, 2004 Office Action, the Examiner rejected Claims 14-19 under 35 U.S.C. § 103 (a) as being unpatentable over *Holshouser* in view of United States Patent No. 5,636,220 to Vook et al. (hereafter *Vook*).

On Pages 10-11 of the October 1, 2004 Office Action, the Examiner rejected Claim 20 under 35 U.S.C. § 103 (a) as being unpatentable over *Holshouser* in view of *Donahue* and further in view of United States Patent No. 6,216,001 to Ghirnkar et al. (hereafter *Ghirnikar*).

The Applicants respectfully traverse (1) the Examiner's rejection of Claims 1-10, Claim 13 and Claims 23 as being obvious in view of *Holshouser* and *Donahue* (2) the Examiner's rejection of Claims 11-12 and Claim 22 as being obvious in view of *Holshouser* and *Donahue* and *Wang*; (3) the Examiner's rejection of Claims 14-19 as being obvious in view of *Holshouser* and *Vook*; and (4) the Examiner's rejection of Claim 20 as being obvious in view of *Holshouser* and *Donahue* and *Ghirnikar*. The Applicants respectfully request the Examiner to withdraw the rejections of the above referenced claims in view of the Applicants' amendments of Claim 1 and Claim 23 and the Applicants' remarks concerning the prior art references.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant

of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Applicants respectfully submit that the Patent Office has not established a *prima facie* case of obviousness with respect to the Applicants' invention. The Applicants direct the Examiner's attention to amended Claim 1 which shows novel and unique features:

1. (Currently amended) A wireless day planner portfolio system, comprising:
 - a first communication device;
 - a second communication device;
 - a processor coupled to the first communication device and the second communication device; and
 - an interface coupled to the processor and the first communication device;

wherein the first communication device, the second communication device, the interface, and the processor are coupled to one another;
wherein a first device that is physically remote from the interface may wirelessly communicate with the first communication device;
wherein a second device that is physically remote from the interface may wirelessly communicate with the second communication device; and
wherein the first device is adapted to wirelessly communicate with the second device via at least the first communication device or the second communication device. (Emphasis added).

The Examiner stated “Regarding claim 1, *Holshouser* teaches a system providing a wireless day planner (see Abstract; Fig. 3).” (October 1, 2004 Office Action, Page 3, Line12-13). The Applicants respectfully traverse the Examiner’s conclusion that *Holshouser* teaches “a wireless day planner.” There is nothing in *Holshouser* that refers to a “day planner.”

The *Holshouser* reference discloses a personal communication terminal (PCT). *Holshouser* states that personal communication terminals (PCTs) are sometimes referred to as personal digital assistants (PDAs). (*Holshouser*, Column 1, Lines 14-15). Therefore, the *Holshouser* device is a PDA. The *Holshouser* reference does not disclose a “wireless day planner portfolio system” that is designed to communicate with a PDA.

In rejecting Claims 14-19, the Examiner stated that *Holshouser* does not explicitly teach the system as being a “wireless portfolio.” (October 1, 2004 Office Action, Page 8, Lines 11-12). The Examiner suggested that because the *Holshouser* system enclosed its elements in a housing, it would have been obvious to one skilled in the art at the time the invention was made “that the ‘portfolio’ as claimed, constituted a type of housing, as disclosed by *Holshouser*.” (October 1, 2004

Office Action, Page 8, Lines 13-15). The Applicants respectfully traverse this assertion of the Examiner for the following reasons.

The “portfolio” as described and claimed by the Applicants is capable of holding objects such as a paper day planner, a binder for holding papers, pockets for holding change (coins), keys, credit cards, or any other accessories. (Specification, Page 15, Lines 12-16). The *Holshouser* housing is a housing for electronic components of a PDA. The *Holshouser* housing does not hold any objects other than the electronic elements of the PDA. Therefore, the *Holshouser* reference does not disclose or suggest the “portfolio” of the present invention.

The *Holshouser* reference does not explicitly disclose a system in which a first device is adapted to wirelessly communicate with a second device through at least a first communication device or a second communication device of a wireless day planner portfolio system. The Examiner suggested that this deficiency could be remedied by combining the teaching of the *Donahue* reference with the teachings of the *Holshouser* reference. (October 1, 2004 Office Action, Page 4, Lines 3-10). The Applicants respectfully traverse the assertion of the Examiner.

Under the applicable patent law, there must be some teaching, suggestion or motivation to combine the *Holshouser* reference and the *Donahue* reference. “When a rejection depends on a combination of prior art references, there must be some teaching, or motivation to combine the references.” *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). “It is insufficient to establish obviousness that the separate elements of an invention existed in the

prior art, absent some teaching or suggestion, in the prior art, to combine the references.” *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997). The Applicants respectfully submit that there exists no teaching, suggestion or motivation in the prior art to combine the teachings of the *Holshouser* reference and the teachings of the *Donahue* reference.

The Examiner stated that the motivation for combining the references would have been (1) to “obtain flexibility” in positioning the first and second devices, and (2) to allow communication between the first and second devices without having the first and second devices “point at each other.” (October 1, 2004 Office Action, Page 4, Lines 5-10).

Evidence of a motivation to combine prior art references must be clear and particular if the trap of “hindsight” is to be avoided. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed.Cir. 1999) (Evidence of a suggestion, teaching or motivation to combine prior art references must be “clear and particular.” “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’”). *In re Roufett*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed.Cir. 1998) (“[R]ejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’”)

The Applicants respectfully submit that the alleged motivation to combine references

presented by the Examiner does not meet the legal requirement to establish a finding of *prima facie* obviousness. The Applicants respectfully submit that the alleged motivation to combine references is not clear and particular. The Examiner stated that it would be obvious to combine the two references, in order to obtain “flexibility” in positioning the first and second devices. (October 1, 2004 Office Action, Page 4, Lines 5-7). The Applicants respectfully traverse this assertion of the Examiner. The desire to arrange two devices in different positions does not without more provide a “clear and particular” motivation to combine the references. Similarly, the desire to arrange two devices so that they do not have to point at each other does not without more provide a “clear and particular” motivation to combine the references. The Applicants respectfully submit that the alleged motivations to combine references has been assumed by “hindsight” in light of the existence of the Applicants’ invention.

For the reasons set forth above, a teaching or suggestion to make the Applicants’ invention and a reasonable expectation of success is not found in the *Holshouser* reference or in the *Donahue* reference (or in any other prior art reference). Therefore, Claim 1 of the Applicants’ invention is not *prima facie* obvious in view of the *Holshouser* reference or the *Donahue* reference.

Claims 2-13 depend from independent Claim 1 and contain all of the unique and novel elements of Claim 1. Therefore, Claims 2-13 are also not *prima facie* obvious in view of the cited prior art. The Applicants respectfully request the Examiner to withdraw the obviousness rejections of Claims 1-13 in view of the Applicants’ remarks concerning the prior art references.

The Applicants hereby reiterate the arguments set forth above and respectfully traverse the Examiner's rejection of Claim 23 under 35 U.S.C. § 103 (a) as being unpatentable over *Holshouser* in view of *Donahue*. For the reasons set forth above, the Applicants respectfully submit that there is no legally sufficient basis for combining the *Holshouser* reference and the *Donahue* reference to reject Claim 23 for obviousness.

The Applicants also reiterate the arguments set forth above and respectfully traverse the Examiner's rejection of Claims 11-12 and Claim 22 under 35 U.S.C. § 103 (a) as being unpatentable over *Holshouser* in view of *Donahue* and further in view of *Wang*. As previously indicated, there is no legally sufficient basis for combining the *Holshouser* reference and the *Donahue* reference. The Applicants also respectfully submit that there is no legally sufficient basis for combining the *Wang* reference with the other two references.

The supposed motivation to combine the *Wang* reference was "to indicate wireless communication status information." (October 1, 2004 Office Action, Page 7, Lines 4-7). The Applicants respectfully submit that the supposed motivation is too general and is not sufficiently clear and particular. Even if the *Wang* reference were to be combined with the *Holshouser* reference it would still not remedy the deficiencies of the *Holshouser* reference.

Therefore, Claim 11-12 and Claim 22 of the Applicants' invention are not *prima facie* obvious in view of the *Holshouser* reference or the *Donahue* reference or the *Wang* reference.

The Applicants also reiterate the arguments set forth above and respectfully traverse the Examiner's rejection of Claim 20 under 35 U.S.C. § 103 (a) as being unpatentable over *Holshouser* in view of *Donahue* and further in view of *Ghirnikar*. As previously indicated, there is no legally sufficient basis for combining the *Holshouser* reference and the *Donahue* reference. The Applicants also respectfully submit that there is no legally sufficient basis for combining the *Ghirnikar* reference with the other two references.

The supposed motivation to combine the *Ghirnikar* reference was to give the user an "appropriate expectation" of an ability to originate or receive messages." (October 1, 2004 Office Action, Page 10, Lines 16 to Page 11, Line 2). The Applicants respectfully submit that the supposed motivation is too general and is not sufficiently clear and particular. Even if the *Ghirnikar* reference were to be combined with the *Holshouser* reference it would still not remedy the deficiencies of the *Holshouser* reference. Therefore, Claim 20 of the Applicants' invention is not *prima facie* obvious in view of the *Holshouser* reference or the *Donahue* reference or the *Ghirnikar* reference.

The Applicants also reiterate the arguments set forth above and respectfully traverse the Examiner's rejection of Claims 14-19 under 35 U.S.C. § 103 (a) as being unpatentable over *Holshouser* in view of *Vook*. As previously indicated, there is no legally sufficient basis for rejecting Claims 14-19 in view of the *Holshouser* reference. The Applicants also respectfully submit that there is no legally sufficient basis for combining the *Vook* reference with the *Holshouser* reference.

The supposed motivation to combine the *Vook* reference with the *Holshouser* reference was to “implement a wireless network.” (October 1, 2004 Office Action, Page 9, Lines 1-3). The Applicants respectfully submit that the supposed motivation is too general and is not sufficiently clear and particular. Even if the *Vook* reference were to be combined with the *Holshouser* reference it would still not remedy the deficiencies of the *Holshouser* reference. Therefore, Claims 14-19 of the Applicants’ invention are not *prima facie* obvious in view of the *Holshouser* reference or the *Vook* reference.

The Applicants therefore respectfully submit that Claims 1-25, as amended, are all patentable over all of the cited prior art references whether taken individually or in combination. The Applicants respectfully request that the rejections of Claims 1-25, as amended, be withdrawn and that Claims 1-25, as amended, be passed to issue.

The Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. The Applicants reserve the right to submit further arguments in support of their above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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